

REMARKS

In the final Office Action, claims 27, 32, 37 and 42 are pending and have been rejected.

Claim Rejections – Non-statutory obviousness-type double patenting

Claims 27, 32, 37 and 42 have been rejected under the judicially created obviousness-type double patenting as allegedly being unpatentable over claims 2 and 8-11 of U.S. Patent No. 5,371,017.

Applicants respectfully traverse the rejection and its supporting remarks. The Examiner acknowledges that “the patent claim 2 is drawn to a generic polynucleotide encoding the entire 686-amino acid protein of Figure 1, ...” That should have ended the analysis as obviousness type double patenting is based upon whether the pending claims of the patent application are obvious over the claims of the issued patent. See, e.g., MPEP 804:

“When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, ***the disclosure of the patent may not be used as prior art.*** *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).” (emphasis added)

However, the Examiner then delves into the disclosure of the issued patent to find embodiments within the issued patent. From review of the disclosure, the Examiner asserts that it would be obvious to the skilled artisan to select the disclosed species in the specification. Based upon this analysis of the disclosed subject matter, the Examiner concludes that “the subject matter of claims 27, 32, 37, and 42 herein are obvious to the artisan in view of ***the teachings of the patent specification.***” As discussed above, whether the disclosure in the specification of the issued patent renders the claims in a pending patent application obvious is irrelevant to an obviousness-type double patenting rejection.

Applicants respectfully request that the Examiner withdraw the rejection of the claims.

CONCLUSION

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 223002010005. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: March 26, 2010

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